



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/445,043	03/20/2000	IAN BAIRD-SMITH	350013-65	9395

7590 01/29/2003
OPPENHEIMER WOLFF & DONNELLY
2029 CENTURY PARK EAST
38TH FLOOR
LOS ANGELES, CA 90067

EXAMINER

HYLTON, ROBIN ANNETTE

ART UNIT	PAPER NUMBER
----------	--------------

3727

DATE MAILED: 01/29/2003

21

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/445,043

Applicant(s)

BAIRD-SMITH ET AL.

Examiner

Robin Hylton

Art Unit

3727

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,6,8-18 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,6,8-18 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- ☐ Interview Summary (PTO-413) Paper No(s). _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Specification

1. The amendment filed October 15, 2002 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "pre-stressed" membrane.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1,3,4,6,8-18 and 22 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no support in the disclosure, as originally filed, for a "pre-stressed" membrane. It is not explicitly set forth in the specification that the membrane is pre-stressed. The specification teaches explicitly that the seal membrane expands toward the disc of the cap 12 (page 11, first paragraph). Any flexible membrane of the same material will function in the same manner.

This is a **new matter** rejection.

4. Claims 1,3,4,6,8-18 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the claims are rejected for the following reasons:

Art Unit: 3727

Since the membrane is not disclosed as being stressed prior to application of the closure to a container neck, it is unclear how the membrane is "pre-stressed".

Dependent claims not specifically mentioned are rejected as depending from rejected base claims since they inherently contain the same deficiencies therein.

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1,3,4,6,8-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hiroshi (JP Application 06219464).

Hiroshi teaches a can having a flexible member 3 secured to the can end, a rigid cap 5 having a laminar member and a skirt 7 extending downwardly from a peripheral edge thereof, and a deformable ring member 6 secured to the rigid cap (see fig. 8).

Hiroshi is silent regarding the spacing between the laminar member and the flexible membrane.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the spacing between the laminar member and the flexible membrane less than the maximum possible extension of the deformable member towards the laminar member to prevent rupture of the flexible member due to excessive pressure within the closed can.

Wherein it is asserted pre-stressing occurs upon application of pressure to the membrane, the membrane of Hiroshi is pre-stressed.

Regarding claim 4, the outer portion 2 of the can comprising the screw threads has an upper edge that is considered to be a flange.

Regarding claim 9, Hiroshi teaches the claimed invention except for the flexible membrane being made of a metal foil. It would have been obvious to one having ordinary skill

Art Unit: 3727

in the art at the time the invention was made to make the flexible membrane of metal foil, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

7. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hiroshi in view of Hardt (US 4,328,905).

Hiroshi teaches the claimed closure except for a pull tab hingedly attached to the membrane. Wherein it is asserted pre-stressing occurs upon application of pressure to the membrane, the membrane of Hiroshi is pre-stressed.

Hardt teaches a membrane closure having a pull tab hingedly attached thereto.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the teaching of a hingedly attached pull tab to the membrane of Hiroshi. Doing so would provide a graspable member to allow for easy removal of the membrane from a container mouth.

8. Claims 1,3,6,9,12-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Owen et al (US 3,833,142).

Owen is silent regarding the spacing between the laminar member and the flexible membrane. Wherein it is asserted pre-stressing occurs upon application of pressure to the membrane, the membrane of Hiroshi is pre-stressed.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the spacing between the laminar member and the flexible membrane less than the maximum possible extension of the deformable member towards the laminar member to prevent rupture of the flexible member due to excessive pressure within the closed can.

9. Claims 1,3,4,6,9-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shull (US 4,531,649).

Art Unit: 3727

Shull is silent regarding the spacing between the laminar member and the flexible membrane. Wherein it is asserted pre-stressing occurs upon application of pressure to the membrane, the membrane of Hiroshi is pre-stressed.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the spacing between the laminar member and the flexible membrane less than the maximum possible extension of the deformable member towards the laminar member to prevent rupture of the flexible member due to excessive pressure within the closed can.

Regarding claim 11, the unsecured end of the membrane functions as a pull tab and is hingedly attached to the membrane radially beyond the end of the container neck.

10. Claims 1,3,6,9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Revill (GB 2,132,392).

Revill is silent regarding the spacing between the laminar member and the flexible membrane. Wherein it is asserted pre-stressing occurs upon application of pressure to the membrane, the membrane of Hiroshi is pre-stressed.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the spacing between the laminar member and the flexible membrane less than the maximum possible extension of the deformable member towards the laminar member to prevent rupture of the flexible member due to excessive pressure within the closed can.

Response to Declaration

11. Applicant's declaration filed October 15, 2002 is insufficient to overcome the rejection of claims 1,3,4,6, 8-18, and 22 based upon the new matter rejection under 35 USC 112, first paragraph as set forth in the last Office action because: although applicant may have intended the term to mean application of stress before and during assembly, the term was not described as such in the originally filed disclosure.

Response to Arguments

12. Applicant's arguments with respect to claims 1,3,4,6,8-18 and 22 have been considered but are moot in view of the new ground(s) of rejection.

13. Applicant's arguments filed October 15, 2002 have been fully considered but they are not persuasive.

Although it is clear the membrane is stressed during the manufacture of the container assembly, i.e., during assembly of the components, the membrane is not pre-stressed. Additionally, how can the membrane be pre-stressed if the closure is not assembled to the container neck?

Regarding applicant's remarks concerning the packing of Hiroshi. At page 5, paragraph 0012 of the translation from Japanese of JP application 6129464, it is stated the "packing 6 which is used is formed from silicon rubber", a well-known resiliently deformable material. Thus, the examiner is not "gleaning more from the document than what the disclosure warrants" as asserted by applicant.

Based upon applicant's assertion of pre-stressed (see pages 4 and 5 of the response), Hiroshi is pressed since the membrane is "acted upon by a force" upon and during application of the closure to a container neck.

Regarding applicant's remarks on page 6 regarding pressure build-up as it affects the membrane, Hiroshi states it is concerned with "treatment under high pressure" (see paragraph 0003). Wherein Hiroshi is specifically concerned with maintaining the seal during retort, the pressure must inherently be building up within the container. Thus, one of ordinary skill in the art would be concerned with spacing of the membrane from the lid.

Conclusion

14. This Office action is made non-final.

Art Unit: 3727

15. In order to reduce pendency and avoid potential delays, Group 3720 is encouraging FAXing of responses to Office Actions directly into the Group at (703) 305-3579. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into Group 3720 will be promptly forwarded to the examiner.

16. It is called to applicant's attention that if a communication is faxed before the reply time has expired, applicant may submit the reply with a "Certificate of Facsimile" which merely asserts that the reply is being faxed on a given date. So faxed, before the period for reply has expired, the reply may be considered timely. A suggested format for a certificate follows:

I hereby certify that this correspondence for Application Serial No. _____ is being facsimiled to The U.S. Patent and Trademark Office via fax number (703) 305-3579 on the date shown below:

Typed or printed name of person signing this certificate

Signature _____

Date _____

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robin Hylton whose telephone number is (703) 308-1208. The examiner can normally be reached on Monday - Friday from 9:00 a.m. to 4:00 p.m. (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee Young, can be reached on (703) 308-2572.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers should be directed to Errica Bembry at (703) 306-4005.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148.

RAH
January 25, 2003


Robin A. Hylton
Patent Examiner
GAU 3727